

R E M A R K S

1. Status of the Claims

After entry of this amendment, the status of the claims will be as follows:

- Claims **1-16, 18-31 and 33-98** are pending;
- Claims **8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86** are withdrawn; and
- Claims **1, 13, 25, 49, 61 and 73** are considered by the Examiner to be generic [See Office Action mailed October 22, 2004 (Paper No./Mail Date 10152004)].

Applicants again note that claims **8-10, 16, 28, 29, 34, 38, 56-58, 64, 76, 77, 82 and 86** are withdrawn, and have not been cancelled. Accordingly, the present amendment includes the text of these withdrawn claims. The Office Action again incorrectly lists only Claims **1-7, 11-15, 18-27, 30, 31, 33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98** as pending. Applicants respectfully request that the status of the claims be corrected commensurate with the Status of the Claims detailed above.

Applicants respectfully request favorable reconsideration and allowance of the present application.

2. The 35 U.S.C. 103 Rejections

Claims 1-7, 11-15, 17-27, 30-33, 35-37, 39-55, 59-63, 65-75, 78-81, 83-85, and 87-98 stand rejected under Section 103(a) as allegedly being unpatentable over U.S. Patent No. 6,014,632 to Gamble et al. (hereinafter “Gamble”) in view of U.S. Patent Publication No. 2002/0049617 to Lencki et al. (hereinafter “Lencki ‘617”).

The Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. In re Fritch, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an unrebutted *prima facie* case of obviousness. In re Rouffet, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. In re Oetiker, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The factual predicates underlying an obviousness determination include the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. In re Rouffet. The secondary considerations are also essential components of the obviousness determination. In re Rouffet.

2.1. Claims 1-7, 11-15, 17-27, 30-33, 35-37 and 39-48 are Patentable over Gamble and Lencki ‘617

Independent claim 1 has been amended to more distinctly claim the invention, and now recites:

offering a benefit to the customer toward the transaction if the customer adopts the preventative treatment;

receiving an indication that the customer agrees to adopt the preventative treatment; and

providing the benefit. (emphasis added)

Independent claims **46-48** have been amended in a similar manner. Support for such changes can be found, for example, on page 6, line 28 to page 7, line 3; on page 23, lines 3-13; and in claims 17 and 32 (which have been cancelled herein). No new matter has been added.

Claims **1 and 46-48** pertain to methods, apparatus and a computer-readable medium for providing a benefit to a customer. In particular, an indication is received that the customer is involved in a transaction with a third party, and then a determination is made regarding a preventative treatment for the customer. Next, the customer is offered a benefit toward the transaction between the customer and the third party if the customer adopts the preventative treatment. The benefit is provided after receiving an indication that the customer agrees to adopt the preventative treatment. We respectfully submit that neither Gamble nor Bro teaches or suggests such operation.

Gamble is directed to apparatus and methods for determining insurance benefit amounts based on groupings of long-term care patients. In particular, the apparatus and method is for efficiently producing an insurance product having an equitable arrangement of benefit amounts for patients requiring long-term care by providing benefit amounts that vary by patient category (see Gamble, col. 5, lines 50-55). The Examiner admits, in paragraph 3 of the Office Action, that Gamble does not disclose determining a preventative treatment, and does not disclose offering a benefit to the customer for the transaction if the customer adopts the

preventative treatment. We respectfully submit that Lencki '617 is not available as prior art, and in any event, does not cure these deficiencies of Gamble.

Lencki '617 is not available as prior art

Lencki '617 is not available as prior art because its December 26, 2000 filing date does not pre-date the effective filing date of the present application. The present application claims priority to U.S. Provisional Patent Application No. 60/208,752, filed June 2, 2000. Although Lencki '617 claims priority to U.S. Provisional Patent Application No. 60/174,056 filed December 30, 1999 ("Lencki '056" hereinafter) and 60/205,338 filed May 18, 2000 ("Lencki '338" hereinafter), Lencki '617 is not entitled to the benefit of these provisional applications for this rejection because the provisional applications do not support the subject matter on which the rejection relies.

"The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph."

MPEP 2136.03(III). Nearly all of the portions of Lencki '617 cited and relied on by the Office Action are not supported by Lencki '056 or '338'. In fact, Figure 9 of Lencki '617, disclosing a general list of available preventative treatments, appears to be the only cited portion of Lencki '617 that is entitled to the earlier priority dates. This figure contains no disclosure or teaching relating to offering a benefit toward a third party transaction in exchange for a customer adopting a particular preventative treatment, however.

Accordingly, the portions of Lencki '617 on which the Office Action relies are not available as prior art. Applicants respectfully request that any rebuttal

arguments be accompanied by specific citations to the Provisional Applications Lencki '056 and '338 themselves.

Lencki '617 fails to cure the deficiencies of Gamble

Even if all of Lencki '617 were available as prior art, and it is not, Lencki '617 still fails to cure the deficiencies of Gamble. The Office Action relies on Page 13, ¶ 0182 of Lencki '617 as disclosing “offering a benefit to the customer towards the transaction if the customer adopts the preventative treatment” and “receiving an indication that the customer agrees to adopt the preventative treatment.” This passage of Lencki '617, however, contains no such teaching. Page 13, ¶ 0182 of Lencki '617 (continued on page 14) lists a number of example rules and/or recommendations for a member to use in selecting insurance benefits, some of which relate to preventative treatments. However, none of these rules or recommendations offer a benefit toward a third party transaction if a customer adopts a preventative treatment.

For example, no combination of any subject matter described in Gamble and Lencki '617 would provide for *offering a benefit to a customer towards a transaction (with a third party) if that customer adopts a preventative treatment* that has been determined for that customer.

Therefore, even if Gamble and Lencki '617 were combined as suggested, and we respectfully submit there is no teaching or suggestion for such a combination, the present invention would not be the result. Any such combination would fail to include offering a benefit to the customer toward the transaction if the customer adopts the preventative treatment that has been determined for the customer, and would fail to include receiving an indication that the customer agrees to the preventative treatment, and would fail to include providing the benefit (towards the transaction), as required by independent claims **1 and 46-48**. Lencki

‘617 at most describes offering additional services (for additional consideration) separate from existing transactions, with no benefit whatsoever offered toward the existing transaction.

Furthermore, even if the customer purchases these additional services, there is no agreement by the customer to actually adopt these services, just as there is no mechanism for verifying that the customer has adopted the services once the services have been purchased. Applicant's remind the Examiner that this and all of other limitations must be given the broadest reasonable interpretation in a manner consistent with Applicants' specification. MPEP 2111. In addition, even if the Examiner determines that the limitation is entitled to a different interpretation than the interpretation being advanced by Applicants, the Examiner's updated search should nevertheless “cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment,” and “the best reference should always be the one used.” MPEP 904.03. Therefore, the updated search and cited prior art must include the interpretation advanced by Applicants. Moreover, the Examiner should not “make a new search in the mere hope of finding something.” MPEP 704.01. This is especially true when, as here, there have been numerous Office Actions on the merits and a thorough search has already been performed and updated several times.

In addition, since claims **2-7, 11-15, 17-27, 30-33, 35-37 and 39-45** each directly or indirectly depend on claim **1**, these dependent claims should be allowable for at least the same reasons.

In view of the above remarks, the Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejections of claims **1-7, 11-15, 17-27, 30-33, 35-37 and 39-48**.

2.2. Claims 49-55, 59-63, 65-75, 78-81, 83-85 and 87-96 are Patentable over Gamble and Lencki '617

Independent claim 49 has been amended, and now recites:

*receiving a first identification of a transaction involving a customer;
transmitting a second identification of a preventative treatment to be adopted by the customer;
receiving an indication that the preventative treatment has been adopted by the customer; and
providing a benefit to the customer toward the transaction. (emphasis added)*

We respectfully submit that the Examiner has failed to cite any reference that teaches or suggests either of *receiving a first identification of a transaction involving a customer*, or of *transmitting a second identification of a preventative treatment to be adopted by the customer* as recited by claim 49. Gamble at col. 1, line 61 to col. 2, line 32 was cited for purportedly teaching such features. But the applicants submit that this cited portion has nothing whatsoever to do with such a process, as it recites:

“Second, beginning in October 1983, in response to rapidly rising hospital costs, Medicare began to reimburse hospitals using a prospective payment system based on Diagnosis Related Groups (DRGs). Before this change, seniors covered by Medicare remained hospitalized until, in most cases, they required only minimal assistance after discharge; this provided hospitals with a very strong financial incentive to keep patients hospitalized for as long as possible. But under the prospective payment system, each patient was assigned to one of 472 different DRGs, each of which had a specific dollar amount allotted to it. The dollar amount was based on the relative severity of the medical condition for the average patient.

Except in extraordinary cases, Medicare paid the hospital that dollar amount for the patient's treatment, regardless of the severity of the patient's actual medical condition. In most cases, if the patient remained hospitalized too long, the hospital spent more for the patient's care than it received from Medicare.

Thus for the first time, hospitals had a very strong financial incentive to release patients before their Medicare money ran out. In 1968, the average hospital stay for seniors was 14.2 days; in 1982, the last year full before the prospective payment system was implemented, the average hospital stay had dropped to 10.1 days; and in 1996, the average hospital stay was only 6.6 days.

Today, almost half of all senior patients need skilled medical care--care that cannot be provided by friends or family--during their recovery after release from a hospital. Technological advances now allow most care provided in a nursing home to be provided in patients' homes. Thus, whether patients recover in a nursing home or in their own home now depends more often on what they can afford. Because home health care for recuperating patients is frequently more expensive than nursing home care, and because the combination of Medicare and private Medigap insurance policies can pay 100% of the costs for nursing home care during the first one hundred days, most recuperating patients are sent to nursing homes even though 75% to 80% strongly prefer to recover at home." (Gamble, col. 1, line 61 to col. 2, line 32).

In addition, the same cited passages of Lencki '617 discussed above with regard to independent claims **1 and 46-48** were again cited as support for the Examiner's positions for what is taught or suggested by the prior art with regard to other features of claim **49**. However, we again submit that Lencki '617 does not suggest or teach *receiving an indication that the preventative treatment has been adopted by the customer, or providing a benefit to the customer toward the transaction* as recited by claim **49**. Thus, for the purposes of brevity, we incorporate by reference herein the same arguments made above concerning the

cited passages of Bro, and again respectfully traverse the Examiner's arguments for the same reasons.

In view of the above amendments and remarks, applicants submit that independent claims **49 and 94-96** are patentably distinct over the cited art. Moreover, since claims **50-55, 59-63, 65-75, 78-81, 83-85, and 87-93** all directly or indirectly depend from claim **49**, these claims should also be allowable.

Accordingly, the applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejections of claims **49, 50-55, 59-63, 65-75, 78-81, 83-85, 87-93, and 94-96**.

2.3. Claims 97 and 98 are Patentable over Gamble and Lencki '617

Independent claim **97** has been amended to more distinctly claim the invention, and pertains to a method for providing a benefit that includes:

receiving a first identification of a transaction between a customer and a third party;

determining a preventative treatment and a benefit;

transmitting a second identification of the preventative treatment and a third identification of the benefit to the customer;

receiving an indication that the preventative treatment has been adopted by the customer; and

providing the benefit toward the transaction between the customer and the third party in response to said indication. (emphasis added)

Support for this change can be found, for example, on page 6, line 28 to page 7, line 3, and on page 23, lines 3-13. No new matter has been added.

Applicants note that the same cited passages of Gamble and Lencki '617 discussed above were again cited to support the Examiner's assertions for what is

taught or suggested in the prior art. However, applicants were unable to identify any verbiage in either cited reference that even suggests *transmitting a second identification of the preventative treatment and a third identification of the benefit to the customer, much less providing a benefit toward the transaction between the customer and the third party in response to the indication* (that the preventative treatment has been adopted), as required by claim 97. Thus, we incorporate herein by reference all of our arguments above regarding what Gamble and Lencki '617 fail to teach or suggest, and respectfully traverse the rejection of claim 97 for the same reasons set forth above.

Accordingly, independent claim 97 is patentably distinct over the cited art, and dependent claim 98 should be allowable for at least the same reasons. The applicants therefore respectfully request withdrawal of the 35 U.S.C. §103(a) rejections of claims **97 and 98**.

Conclusion

For the foregoing reasons it is submitted that all of the pending claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

If there remains any question regarding the present application, or if the Examiner has any suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Applicants' representative.

Petition for Extension of Time to Respond and Fees

Applicants hereby petition for a two-month extension of time with which to respond to the Panel Decision mailed on October 1, 2007. Please charge the fee for this petition to our Deposit Account No. 50-0271, along with the fees pursuant to 37 C.F.R. 1.17(e) for this request for continued examination.

Applicants do not believe that any other fees are due. But if a fee should be necessary to continue prosecution of the present application, please charge any such required fee to our Deposit Account No. 50-0271, and credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

October 13, 2008
Date

/Jerome DeLuca, Reg. No. 55,106/
Jerome A. DeLuca
Attorney for Applicants
Registration No. 55,106
jdeluca@walkerdigital.com
(203) 461-7319 /voice
(203) 461-7300 /fax